

## **REMARKS/ARGUMENTS**

### **Status of the claims**

Claim 1, 36, 52, 61, 65, 66 and 68 are herein amended. Claim 12, 48 to 51, and 53 to 55, 59, 60, 67, and 69 are canceled without prejudice. Claim 71 is new. After entry of these amendments. Claims 1, 6-8, 10, 11, 36, 37, 43-45, 47, 52, 61, 62, 65, 66, 68, 70, and 71 will be pending.

All the previously pending claims stood rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,936,747. Although the conflicting claims are not identical, they are allegedly not patentably distinct from each other because: 1) with respect to claims 1, 6-8, 10-12, 36, 37, 43-45, 47-55 and 58-60, the cells of the instant claims would have been produced by the patented method; and 2) with respect to claims 61-71, the instant claims encompass all that is claimed in the patented claims, i.e., are generic thereto.

Claim 12 stands rejected for alleged indefiniteness.

### **Support for the amendments to the claims**

All the independent claims as amended now set forth the attB and attP recombination sites are bacteriophage  $\Phi$ C31 integrase recombination sites. Support for this subject matter finds support in the earlier versions of the claims.

Claims 1 and 52 were amended to further set forth a cell having *only one* attP or *only one* attB recombination site integrated in the genome. Support for this subject matter can be found *inter alia* in Figure 5 and elsewhere.

Claim 36 was amended to set forth a non-genomic nucleic acid comprising a heterologous nucleic acid or a transgene, and *only one* attP site if the cell has the genomic attB site or *only one* attB site in the non-genomic nucleic acid if the cell has the genomic attP site. Support for this subject matter can also be found *inter alia* in the figures.

Claim 61 was amended to set forth an attB recombination or an site attP recombination site integrated in the genome and a non-genomic nucleic acid comprising a

transgene or a heterologous nucleic acid having only one *attP* site if the cell has the genomic *attB* site or only one *attP* site if the cell has the genomic *attB* site. Support for this subject matter is as discussed above.

Claim 65 was amended to incorporate the limitations of its base claim.

Claims 66 and 68 were amended to incorporate limitations of their respective dependent claims, claims 67 and 69.

New claim 71 sets forth a plant regenerated from a plant cell of claim 1. Support for this subject matter can be found in the paragraph bridging pp. 21 and 22.

Accordingly, the Applicants submit that the amendments to the claims add no new matter and respectfully request their entry.

**Response to the rejection for alleged obviousness-type double patenting over U.S. Patent No. 6,936,747.**

The claims of the '747 patent require at least *two* IRS and *two* CIRS sequences that flank the donor and receptor polynucleotides, respectively. The operability of the claimed *replacement* methods of the '747 patent also requires at least two flanking sites for each of the donor and receptor polynucleotides. Without acquiescing on the merits and in the spirit of expediting examination, the Applicants have amended independent claims 1, 36, 52, and 61 to further distinguish their subject matter from that claimed in the '747 patent. As amended, these claims set forth subject matter wherein *only one* of the *attB* or the *attP* site is present on a polynucleotide. Accordingly, the subject matter of claims 1, 36, 52 and 61 and their dependent claims are patentably distinct from those of the '747 patent which requires a nucleotide flanked by *at least two* IRS sequences and a nucleotide flanked by *at least two* CIRS sequences.

Without acquiescing on the merits and in the spirit of expediting examination, Claim 65 was amended to set forth all the limitations of its previous base claim and is now in independent claim format. As amended, the claim sets forth that both the *attP* and *attB* recombination sites are on the same nucleic acid. This amended claim further embraces subject matter where the recombination sites are in an inverted orientation such that the intervening sequence is inverted upon contact with the integrase, and subject matter where the recombination sites are in direct

orientation such that the intervening sequence is excised upon being contact with the integrase. Accordingly, claim 65 is not drawn to methods of replacing a receptor polynucleotide with a donor polynucleotide as set forth in the '747 patent claims.

Accordingly, the Applicants believe the amended claims are free of any obviousness-type double patenting concern, and respectfully request reconsideration and withdrawal of this grounds of rejection.

**Response to the rejection of claim 12 for indefiniteness.**


Without acquiescing on the merits and in the spirit of expediting examination, claim 12 was canceled. New claim 70 is drawn to a plant but is believed to be free of any indefiniteness. Accordingly, the Applicants respectfully request that this grounds of rejection be reconsidered and withdrawn.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

  
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